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In re Application of  
JEHA et al.  
Serial No.: 10/533,940  
PCT No.: PCT/AU04/00810  
Int. Filing Date: 21 June 2004  
Priority Date: 20 June 2003  
Attorney's Docket No.: 4398-207  
For: BREATHABLE GAS APPARATUS WITH  
HUMIDIFIER

DECISION ON  
PETITION UNDER  
37 CFR 1.497(a) & (b)

This is a decision on applicants' "Response to Decision on Response to Notification of Missing Requirements" along with a petition under 37 CFR 1.47(a), filed on 24 May 2006 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 04 May 2005, within the thirty month period, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee. On 08 July 2005, applicant filed a declaration executed only by Andrew Charles Murray, Mark John Payne and Simone Marie Jeha (who were not identified in the published International application).

On 24 October 2005, a Notification of Missing Requirements was mailed to applicant indicating that the oath or declaration was not executed in accordance with either 37 CFR 1.66 or 1.68 and drawing applicant's attention to the fact that the declaration had not been executed by inventors listed on the International Application.

On 30 November 2005, applicant filed a Response to the Notification of Missing Requirements. On 16 March 2006, a decision was mailed to applicant, indicating the declaration did not identify all the inventors and thus, did meet the requirements of 37 CFR 1.497(a) and (b) and was unacceptable.

On 24 May 2006, applicant filed a "Response to Decision on Response to Notification of Missing Requirements" and a petition under 37 CFR 1.47(a).

**DISCUSSION**

Petitioner argues that the declaration submitted on 08 July 2005 met the requirements of 37 CFR 1.63 and thus, 37 CFR 1.497(a) and (b). Andrew Charles Murray, Mark John Payne and Simone Marie Jeha were added as inventors during the international phase under PCT Rule 92bis.

A review of the 08 July 2005 declaration reveals that only the inventors, who were added, were listed thereon. The inventors listed on the published international application were not identified on the declaration submitted on 08 July 2005 and are required by 37 CFR 1.41(d).

37 CFR 1.41(d) states, in pertinent part: "The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis". Thus, the 08 July 2005 declaration does not meet the requirements of 37 CFR 1.497(a) and (b).

With the exception of inventor Marek Tomasz Supula, the declarations submitted on 24 May 2006 are executed by all the inventors named in the international application including those added under PCT Rule 92bis. Petitioner has presented a petition under 37 CFR 1.47(a) with regard to the signature of inventor Marek Tomasz Supula.

Petition under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), Petitioner has authorized payment of petition fee of \$200 under 37 CFR 1.17(g) from his deposit account. Thus, item (1) has been satisfied. Item (3) has been satisfied with the non-signing inventor's last known address. As noted above, Item (4) is satisfied with the declaration filed with the petition, which is in compliance with 37 CFR 1.497(a) & (b).

However, Item (2) has not been satisfied.

MPEP § 409.03(d) states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for

refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, Petitioner has not demonstrated that a complete copy of the application papers including the specification, claims and drawings was sent to inventor Supula. A statement of first hand knowledge was not presented regarding the details of attempts to secure the signature of Mr. Supula, i.e., delivery of the application papers, telephone calls, email messages, etc. Details regarding the date, time and place of the attempts is required.

As noted above, a complete copy of the application must be provided to the inventor to assure that the non-signing inventor is apprised of the application to which the declaration is directed. Thus, in light of the MPEP §409.03(d) instruction regarding an inventor's refusal to sign, Petitioner has not established a refusal to sign.

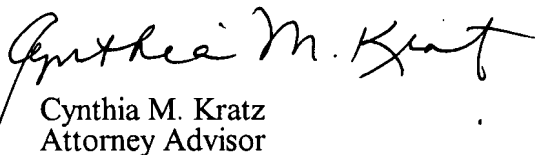
Item (2) is not yet satisfied and thus, the petition under 37 CFR 1.47(a) is dismissed without prejudice.

#### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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